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Tatsuya Shimoji

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EXAMINER

JOHNS, CHRISTOPHER C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,836	Applicant(s) SHIMOJI ET AL.	
	Examiner Christopher C. Johns	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Claims 1, 2, 5, 6, and 15 are pending.

Claim Objections

2. Claim 15 is objected to for containing "an upper-level resource to be first referred to..." (page 6, lines 3). This is assumed to be "first referred to".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 6, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2004/0143760 ("Alkove") in view of United States Patent 5,629,980 ("Stefik").

5. As per claim 1, 5, 6, and 15, Alkove teaches:

6. content storage section for storing the content (it is inherent in the art of computing to have content storage sections, such as a hard drive or memory, as this is how digital items are stored and used);

7. an upper level resource to be first referred to within the content (figure 2, reference 202-1) and to be displayed (the information in the header may be displayed, as they include

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information that is typically displayed by media playback devices, such as "title, artist, etc."
(table 1, ATTRIBUTES));

8. a lower-level resource to be referred to from the upper-level resource (figure 2, reference 204-1) and to be displayed (the data objects are the displayed portion, as this is part of the file that is viewable);
9. a startup document (figure 2, reference 202) providing a plurality of pieces of license information (figure 2, reference 202-1 - 202-N), each respective piece of license information identifying a view license required for viewing all or a part of the resources included in the content, each respective piece of license information corresponding to one of reference destination information of the upper-level resource and a predetermined usage rule (figure 4, reference numbers 408-414; ¶0026 – “STREAM_ID – specifies the particular data stream(s) that are to be licensed/decrypted...”);
10. communication processing section for receiving a presentation request for a resource from the receiving terminal (figure 3, reference numbers 377-380, 382);
11. when the requested resource is contained in the content that is currently being viewed, presenting the requested resource to the receiving terminal (inherent in the operation of the system in Alkove, as this allows currently-viewed and selected media to be viewed);
12. receiving terminal comprises a communication processing section for receiving, when the content to be viewed has changed, the plurality of pieces of licensing information provided from the server (figure 1, arrows between reference numbers 108 and 110);
13. view processing section for, each time the plurality of pieces of license information are provided from the server, setting for view processing all view licenses identified by the plurality

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of pieces of license information provided from the server and executing the view processing on a resource distributed from the server by using all the view licenses set for the view processing (figure 1, reference numbers 110, 118).

14. Alkove does not explicitly disclose:

15. content including information referring to a startup document of another content that is different from the content and being described in link information for accessing resources of the other content, when the requested resource is contained in the other content that is not currently being viewed, presenting the upper-level resource to the receiving terminal and providing the receiving terminal with the plurality of pieces of license information based on a description of the startup document of the other content, the startup document of the other content being referred to in the link information.

a. Stefik discloses content which includes information that refers to another content (figures 7-9) using "pointers" (see especially figure 11). Stefik discloses license information for each content (figure 7, reference 704), and using the upper-level resource (figure 11, reference 1101) to refer to each of the contents (figure 11, reference 1102-1105).

b. This is done in Stefik to provide for a more granular system of controlling digital media (making a more robust and easily-controlled system), and to transport "the means for billing" with the digital work (resulting in a more convenient system).

c. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Alkove to contain links to other content and

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present the upper-level resource, as in Stefik, because it would result in a more easily-controlled and convenient system. A person having ordinary skill in the art would see this as advantageous because it would allow for a system where multiple works could be distributed at once, and both billing and rights management could be separately managed for each work.

16. As per claim 2, Alkove discloses as above, and further discloses:

17. plurality of view licenses are previously stored in the server (figure 1, reference numbers 108, 110) and the receiving terminal obtains from the server the plurality of view licenses set for view processing (figure 1, reference number 118).

Claim Interpretation

18. In accordance with MPEP §2111.01, the Examiner has interpreted the meaning of claim limitations in accordance with their "plain meaning", unless such terms have been defined explicitly in the specification.

19. The Examiner notes that claims 1, 5, and 6 contain heavy amounts of language that communicates the intended use of the structures claimed. For example, claim 1 recites "a content storage section for storing...a communication processing section for receiving...a view processing section for...setting". These words are seen as describing the intended use of the structure, rather than their actual structure. In light of the notice function of the claims, the

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Examiner again requests changing “for (action)” to “programmed to” where a positive recitation is desired¹.

20. In addition, recent amendments to the claims note that "resources" are "to be displayed". Nothing in the claim contains the limitation of displaying the resources; the limitation merely notes that the resources are "to be displayed"; this is seen as an intended use (MPEP §2106 II C).

21. Claims 1 and 5, in discussing the steps taken when the "requested resource" is either contained in the currently-viewed content or not. Were a system to always receive presentation requests whose requested resources were always contained in the currently-viewed content, the steps in (iii) ("presenting the upper-level resource to the receiving terminal...") would not be performed. As such, they are seen as optional elements. Optional or conditional elements do not narrow claims because they can always be omitted. See *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted"), and MPEP §2106 II C, which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (emphasis in original text).

¹ See MPEP §2114 - "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" (emphasis mine). The Manual then cites important precedent: "*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)."

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

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25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

26. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns
Examiner
Art Unit 3621

CCJ

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621